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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,727	11/13/2001	Ronald James Ogilvie	PCS10946A	3580

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EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/054,727

Examiner

Andrea D Small

Applicant(s)

OGILVIE, RONALD JAMES

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION*****I. Election/Restrictions:***

In response to the restriction election requirement, Applicants have elected group V, claims 12-23 with traverse. Applicants traversal is on the grounds that (a) the subject matter in the application if examined together would not impose a serious burden on the office and (b) that the core subject matter recited in the non-elected groups I-IV is necessarily related to the subject matter of group V and hence relevant art would be applicable to all groups. The examiner respectfully disagrees.

Restriction under 35 USC 121 is based on distinctiveness between groups and the seriousness of the burden imposed on the office to examine all groups in one application. Instantly, the distinctive quality of each group one from the other has been outlined in the office action of paper no. 6, pages 2-3. Applicants reference to the core subject matter of all groups being related is NOT the criteria that determines distinctiveness, rather, the difference in structure and element, the variation in product versus process and in process, the distinct products prepared based on their structure and element. Furthermore, a reference that would anticipate but one of the groups would not render the other group obvious. For instance, a reference that anticipates the product claimed in group V is would not render the process claimed in group I obvious. Secondly, examining all the groups in one application would impose a serious burden on the office as examining a process involves searching the methods of preparing a certain compound, including the specific reagents and intermediates employed. Searching products involves searching the product itself regardless of process or preparing it or the end utility. Searching distinct products involves separate search criteria and separate search

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considerations as well as separate classes and subclasses. These searches if conducted in one application would impose a serious burden on the office.

For these reasons and the reasons provided in office action of paper no. 6, the restriction as outlined is proper and made FINAL.

## ***II. Pending Claims:***

(a) Claims 1-23 are pending.

(b) Claims 1-18 are withdrawn from consideration as being drawn to non-elected inventions. 37 CFR 1.142(b).

(c) Claims 19-23 are examined herein.

## ***III. Rejections:***

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Macor, et al (US 5,545,644).

Applicants claims relate to eliotriptan and its acid addition salt (hydrobromide) 'substantially free' (this reads on an amount  $>0$ ) of a dimer of eliotriptan precursor. Macor, et al teach eliotriptan and its acid addition salt (hydrobromide). See col. 2, lines 55-68. The reference also teaches a process of making the same. See col. 49, examples 32-34. The chemical compounds recited in the reference are prepared from the same precursor that is prone to forming

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the dimer and hence would result in the product that has an amount ( $>0$ ) of dimer in the end product as is instantly claimed. Hence, the reference anticipates the instant claims.

#### **IV. Contact Information:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.  
April 29, 2003

  
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Joseph K. McKane  
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